



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,083	12/08/2006	Claus Permesang	BE-172PCT	4320
40570	7590	11/19/2009		
FRIEDRICH KUEFFNER				
317 MADISON AVENUE, SUITE 910				
NEW YORK, NY 10017				
EXAMINER				
LAUX, JESSICA L				
ART UNIT		PAPER NUMBER		
3635				
MAIL DATE		DELIVERY MODE		
11/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,083

**Applicant(s)**

PERMESANG, CLAUDE

**Examiner**

JESSICA LAUX

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4 and 6-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 8/21/2009 have been fully considered but they are not persuasive.

Fowler does disclose an intermediate layer as recited in the claim where the intermediate is not, as applicant suggests in the remarks, layers 17 or 18 but rather the adhesive layer as noted in paragraph 0020 of Fowler. It is noted that the limitation that the layer is sprayed or foamed on is a product by process limitation and so long as the prior art is capable of the limitation it anticipates the claim (as noted below). In the instant case the adhesive layer of Fowler is capable of being sprayed or foamed in place, therefore applicant's arguments are not persuasive to overcome the rejection.

As noted below the adhesives as disclosed below (Fowler paragraphs 0058-0061) do act as a bordering that encircles the building component where the intermediate layer and the bordering as disclosed below are both adhesives thereby being the same material.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-11, 13-17, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fowler (20040031225).**

Claims 1, 4,6, 10, 19-21. Fowler discloses a flexible building system having building component for forming floor and/or wall coverings comprising a support layer (16) and a layer which is connected to the support layer, a floor and/or wall forming layer made of at least one coating element (17, 18, 19) as well as elastic devices (20, 22) for connecting similar building components applied to a floor or a wall; wherein the support layer is connected by means of an intermediate layer (the chemical adhesive of paragraphs 0020 and 0058-0062, which disclose an adhesive on the coupling parts acting as a preglue) to the at least one coating element (17, 18,19).

It should be noted that claims 5, 10 are considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case the adhesive is capable of being foamed or sprayed in any manner on the support layer and the coating element and the devices for connection are capable of being molded together to the intermediate layer.

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (paragraphs 0032, 0058).

Claim 8. The building component according claim 1, wherein the support layer is made of recycling material (paragraph 0021).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (paragraphs 0023-0024).

Claim 11. The building component according to at claim 1, wherein the devices for connecting are connector devices (20, 22) for tongue-and-groove joints.

Claim 13. A building component according to claim 10, wherein engaging connector devices are provided (as seen in figures 2-3).

Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the layer encompassing the coating element (as seen in the figures).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figure 2).

Claim 16. The building component according to claim 10, wherein an element having the tongue or groove is connected in one piece with the intermediate layer (as seen in figures 2-3).

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile (as seen in the figures).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (at 23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (20040031225) in view of Miller (2003020980).**

Claim 12. Fowler discloses the building component according to claim 11, where a tongue is formed opposite a groove, however Fowler does not disclose that a groove is tongue and groove are formed at two sides respectively. Rather Fowler discloses that a tongue and groove are formed at one side.

Miller discloses a building component having layers and a tongue formed opposite a groove, where the groove is at two adjacent perpendicular sides and the tongues are opposite the grooves (figure1).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the component of Fowler to have two perpendicular sides with a groove and the opposite sides with a tongue to improve the connection between adjacent placed building components.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler (20040031225) in view of Milborn (2548036).**

Claim 18. Fowler discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer.

Milborn discloses a panel for use in flooring having layers and pipes for heating a floor made of the panels (see figures; disclosure).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Fowler to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/J. L./  
Examiner, Art Unit 3635